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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hajime Matsubara

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/805,157

Applicant(s)

MATSUBARA, HAJIME

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/12/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 2, 4,5 and 7-18 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/07 has been entered.

Response to Amendment

3. The Amendment filed on 1/5/07 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 4,5 and 7-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The independent claims contain the new features added with the claim amendments dated 1/5/2007 stating, "wherein the passage count is a continuous counter for a time period exceeding the predetermined period of time".

And, Applicant did not state where support for these new features could be found. And, upon a thorough searching and reading of the Applicant's Specification, Examiner could not find 35 USC 112 support for these features. The closest paragraphs that Examiner could find to be relevant to these features were paragraphs [67, 74, 75, 76] in the Applicant's Specification. However, these paragraphs were not found to provide adequate 35 USC 112 support for the features stated above. Hence, Applicant must amend the claims to remove these features or demonstrate where adequate 35 USC 112 support can be found.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 7, 9-12, 14-17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitzuka (6,366,298) in view of Cohen (6,236,330) and in further view of McGregor (5,250,941).

Claim 1, 7, 12, 18: Haitzuka discloses a method, medium transmitting advertising information, comprising:

Art Unit: 3622

receiving position information from a client (col 5, line 59-col 6, line 4; col 6, lines 42-45);

determining a passage count of the client in a predetermined advertising information transmission area in which the position information belongs and storing the passage count; and transmitting to the client advertising information according to the passage count of the client in the transmission area (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Art Unit: 3622

Haitsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Additionally, Haitsuka discloses tracking a user geographically and that a variety of rules can be utilized for determining to send advertising (Fig. 3).

Haitsuka further discloses changing advertisements after certain periods of time (col 2, lines 48-50) and recording what advertisements a user was exposed to, for how long, when, etc (col 2, lines 62-67) and controlling the frequency of which a user sees an advertisement (col 6, lines 17-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize user exposure to advertising or time duration of exposure as a parameter of whether to show a user new advertising or not. One would have been motivated to do this in order to better control the amount of exposure a user receives to particular advertisements.

Also, Haitsuka discloses changing advertisements after certain periods of time, adjusting content based on frequency, maximum views by an individual, time periods, time frames, profiles, and geographic information:

“(12) Sophisticated systems have the capability to change the advertisement after a certain period of time” (col 2, lines 47-50);

(19) The data to be sent to users preferably has scheduling requirements that dictate when it should be sent. These scheduling requirements may include, for example: frequency, maximum number of times to send to an individual, minimum number of times to send to an individual, time of day to send, and first and last days to send. The data to be sent to users can have demographic requirements that dictate to whom it should be sent. These include (but are not limited to): personal profile, interactive data, network usage information and geographic location” (col 6, lines 17-29).

McGregor (5,250,941) discloses tracking and counting a mobile user's passing through a predetermined area over a certain time frame (col 1, lines 5-25; col 2, lines 5-11; col 2, line 64- col 3, line 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. Therefore, it would be obvious that Haitsuka would only send one advertisement to the user for a certain time period for a certain location/region. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users without oversaturating the user with the same advertisement.

Art Unit: 3622

Additionally, Examiner notes that claim 1 is interpreted as the passage count equaling zero or one for the specified time period. That is, as claim 1 is written, the passage count is always zero or one since the passage count of two or more are disregarded. The predetermined area and the predetermined time period vary. However, the passage count is always zero or one. Also, as stated in Claim 1, the passage count is utilized to determine whether or how much advertising to send to the user. Claim 1 states, "transmitting to the mobile client advertising information according to the passage count of the mobile client. . .". Hence, claim 1 is interpreted as stating that if a mobile client passes thru a predetermined area during a predetermined time period the mobile client is sent a maximum of one advertising information for the designated time period.

And, Examiner notes that it is the combination of Haitzuka and McGregor which renders obvious the Applicant's claimed features of sending a maximum of 1 piece of advertising information in a given time period to a user who passes thru a predetermined area in the given time period.

Also, Examiner notes that the claim 1 could be interpreted as the Applicant has stated on page 8 and in the quote above. However, the claim states one predetermined period of time. That is, the claims do not necessitate a predetermined period of time such as 5 minutes and a second larger time period such as 25 minutes. That is, there is only one predetermined period of time stated in claim 1. Hence, the predetermined period of time could be the same as the entire period over which the passage count is taken. That is, the predetermined period of time could be 25 minutes and the entire period over which the passage count is taken can be 25 minutes. The claims do not state that the passage count is a continuous counter for a time period that is greater

Art Unit: 3622

than the predetermined period of time. Hence, the combination of the prior art renders obvious a passage count over a predetermined period of time where the passage count is not incremented over one for that predetermined period of time.

Examiner notes that the prior art above discloses that the passage count above is within the predetermined period of time.

Also, the combination of the prior art renders obvious the features of a fee for distributing advertising information throughout the predetermined advertising information transmission area is determined based on an amount of traffic in the predetermined advertising information transmission area, a time period in which the advertising information is distributed, or attributes of the predetermined advertising information transmission area in which the advertising information is distributed:

Examiner notes that as the claims are written, a fee for distributing advertising information throughout the advertising information transmission area can be determined based on any of the factors stated in the paragraph preceding.

And, Haituka discloses charging for advertising based on certain time periods:

“(19) The data to be sent to users preferably has scheduling requirements that dictate when it should be sent. These scheduling requirements may include, for example: frequency, maximum number of times to send to an individual, minimum number of times to send to an individual, time of day to send, and first and last days to send. The data to be sent to users can have demographic requirements that dictate to whom it should be sent. These include (but are not limited to): personal profile, interactive data, network usage information

Art Unit: 3622

and geographic location (col 6, lines 17-28);

Moreover, advertisers prefer to pay for advertising based upon the number of relevant consumers who are actually exposed to the advertisement. For typical on-line systems and networks, including the Web, it is often difficult for an advertiser to precisely determine whether its advertisements were actually viewed by a user and for how long, and whether the advertisement induced a response. Accordingly, there exists a need for a targeted advertisement system that also can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times“ (col 2,lines 55-67) .

Haitsuka further discloses varying fees charged to advertiser based on different factors (col 2, lines 40-63).

Cohen further discloses charging for advertising to a predetermined area based on a variety of different factors including time period, attributes of the area such as density for that area, and other factors related to the area:

“The message is displayed pursuant to a schedule which includes date, time of day and display duration while the display is within the zone or until the display is located in another zone which is not included within the message schedule. A tiered system control network includes a plurality of fixed stations which transmit message content and scheduling data to the controller and which generate billing and other accounting records (Abstract);

(6) Advertising was known to be time and location sensitive. Among the disadvantages heretofore encountered with visual displays has been the inability to efficiently deliver the intended message to a target audience in

Art Unit: 3622

desired geographic zones and specified time slots so that advertising revenues could be maximized in accordance with the value delivered. (col 1, lines 27-34)

(9) Similarly, business which desired to attract children, e.g. amusement parks, did not wish to bear costs associates with mobile billboard displays when their target customers were not available, e.g. during the times of day when children were in school or in the late evening.

(10) There was a further need to target precise visual messages directed to a particular location and time of day at minimal expense.

(11) The advertiser's needs with respect to receiving advertising billing which reflected specific desired dates, times of day, duration of display, specific locale wherein the advertiser's message was displayed were also unfulfilled (col 1, lines 44-56);

(17) The stations 20, 22, 24 process the current status data to monitor display density, i.e. number of displays each zone, and will communicate with the controllers to display alternate messages if the transporter density displaying a selected message is greater than specified. The stations also process the transaction records to generate periodic advertiser billing which identifies the displayed message, the physical locations wherein such message was displayed, the dates and times, and monitored parameters and the charges due based upon the appropriate billing rates (which can vary based upon location, time of day, monitored parameters, and density). The advertiser billing is transmitted to an advertiser 28 via conventional mail, E-mail,

Art Unit: 3622

facsimile or other means (col 5, lines 20-33).

(19) The fixed location stations 20, 22 and 24 may also be in communication with a master control base 32 which receives the transaction data and billing data, accesses memory stored customer profiles and serves an overseeing function which includes analysis of the transaction and billing records, revision of fee schedules, revision of physical zone definitions and disaster recovery functions for the stations” (col 5, lines 38-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cohen’s other factors by which to charge for advertising to Haitsuka’s different factors by which to charge for advertising. One would have been motivated to do this in order to more appropriately charge for relevant advertising.

Additionally, Haitsuka does not explicitly disclose that the advertising information is transmitted when the passage count of the client has reached a predetermined value.

However, Haitsuka discloses monitoring user activities including geographic activity, and user interactivity, and other user activity (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5), and that the advertiser can utilize a wide range of criteria for sending advertising (Fig. 3; col 6, lines 13-28), and that the frequency of advertisements can be set (col 6, lines 13-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can make user visits to a certain area a criteria for sending advertisements. One would have been motivated to do this in order to target users who are often in a certain area.

Claim 2: Haitsuka and Cohen and McGregor disclose the method according to claim 1.

Haitsuka further discloses that the advertising information according to the passage count of the client in the transmission area is transmitted to the client in response to reception from the client of a request to transmit advertising information (col 4, lines 52-56).

Claim 4: Haitsuka and Cohen and McGregor disclose the method according to claim 1.

Haitsuka does not explicitly disclose that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules.

However, Cohen discloses that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules (col 5, lines 45-52; col 1, lines 34-39; col 1, lines 52-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cohen's overlapping zones with advertising to Haitsuka's targeting advertising geographically to a user. One would have been motivated to do this in order to provide a range of advertisements for different areas or overlapping areas.

Claim 9: Haitsuka and Cohen and McGregor disclose the method according to claim 1, and Haitsuka further discloses that the transmission area is divided in transmission time periods, and a different piece of advertising information to be transmitted to the client in the transmission area is registered for each transmission time period (col 2, lines 48-50; col 6, lines 17-27).

Art Unit: 3622

Claim 10: Haitsuka and Cohen and McGregor disclose the method according to claim 9, and Haitsuka further disclose that different pieces of advertising information according to the transmission area and the transmission time periods are transmitted to the client (col 2, lines 50-60; Fig. 3, item 140f).

Claim 11: Haitsuka and Cohen and McGregor disclose the method according to claim 10, and Haitsuka further disclose that when the client is passing through the transmission area, advertising information according to the passage count in the corresponding the transmission time period is transmitted to the client (Fig. 3).

Claim 14, 15: Haitsuka discloses a method, medium receiving advertising information, medium comprising:

transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45);
receiving from the server advertising information according to the count of passage through that transmission area at that time, when passing through an advertising information transmission area in which the position information belongs (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic

Art Unit: 3622

information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Haitsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user

Art Unit: 3622

frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

Claim 16: Haitsuka discloses a method receiving advertising information, comprising: transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45); transmitting a request for transfer to the server (Fig. 3); receiving the count of passage through a transmission area for the advertising information at the time of transmission of the transfer request or corresponding incentive information to the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and storing the received passage count or incentive information on a portable external storage medium (col 4, lines 13-20).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further

Art Unit: 3622

discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Hairsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Hairsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Hairsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Hairsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising.

Art Unit: 3622

One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

6. Claim 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitzuka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Bandera (6,332,127).

Claim 5, 13: Haitzuka discloses a method transmitting advertising information, comprising:
setting up conditions assigning targeted advertising and advertising information in a predetermined advertising information transmission area (col 2, lines 50-60);
receiving position information from a number of clients (col 5, line 59-col 6, line 4; col 6, lines 42-45);
determining the state of passage of each of the clients in the transmission area in which the position information from the clients belong (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and
assigning the advertising information to the client or clients that meet the conditions on the basis of the state of passage (col 2, lines 50-60; Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Haitsuka does not explicitly disclose incentives distinct from advertising.

However, Bandera further discloses incentives distinct from advertising (col 3, lines 19-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's incentives and advertising to Haitsuka's advertising for promotional purposes. One would have been motivated to do this in order to keep better track of different types of advertising and the response to different types of advertising.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Gough (6,360,221).

Claim 8: Haitsuka and Cohen and McGregor disclose the method according to claim 1.

Haitsuka further discloses fees and user control over content (col 2, lines 35-41; col 4, lines 53-56).

Haitsuka does not explicitly disclose that the transmission of advertising information to the client is omitted as instructed by the client.

However, Gough discloses that the transmission of advertising information to the client is omitted as instructed by the client (col 6, lines 30-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gough's omission of advertisements to Haitsuka's user control of content. One would have been motivated to do this in order to provide better user control over user paid services.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Eggelston (6,061,660).

Claim 17: Haitsuka discloses a method receiving advertising information, comprising:
receiving a transmission management database which defines transmission criteria for advertising information (Fig. 3, 140c);
retrieving from the database a count of passage through the transmission area through which it is passing based on position information of a client, and storing the count of passage (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5);

Art Unit: 3622

transmitting to the server a request for transmission of advertising information and the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and

receiving from the server advertising information according to the passage count in the transmission area at time of the transmitting (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas and the utilization of advertising (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Art Unit: 3622

Eggleston further discloses the utilization of awards points as an incentive and related to advertising purposes.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's utilization of points to Hairsuka's advertising. One would have been motivated to do this in order to entice regular users.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Hairsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Hairsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Hairsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Art Unit: 3622

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

On page 10 of the Applicant's Remarks dated 1/5/2007, Applicant states that the combination of the prior art does not render obvious, "that the passage count is a continuous counter for a time period that is greater than the predetermined period of time".

However, please see the 35 USC 112 rejection above concerning these features.

On page 11, Applicant states:

"This reference [Haitsuka] relates to a monitoring method for an online user, not to a passage count of a mobile body. Moreover, Haitsuka only describes frequency, maximum number of times to send to a user, minimum number of times to send to a user, etc., as data transmission methods. Because Haitsuka relates to online users, there is no motivation to combine Haitsuka with the other references, such as Cohen. Even if the references would have been combined, the present invention, in which advertising information is transmitted when a passage count of the mobile client has reached a predetermined value, is not disclosed or suggested."

However, while Haitsuka discloses that the user can be online, Haitsuka also discloses that the online user can be mobile. Haitsuka discloses that the user can utilize the Internet, a wireless network, a portable device, a PDA, a mobile phone(col 4, lines 5-30) and can track

Art Unit: 3622

mobile or traveling users (col 2, lines 50-60). Hence, Haituka does apply to the Applicant's claims.

And, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner further notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, USPQ 12 (CCPA 1977).

Also, Examiner notes that the person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955,962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986).

In determining this skill level, the court may consider various factors including "type of

Art Unit: 3622

problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *Id.*, cited in *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

And, as noted in the rejection above, Haitsuka does not explicitly disclose that the advertising information is transmitted when the passage count of the client has reached a predetermined value.

However, Haitsuka discloses monitoring user activities including geographic activity, and user interactivity, and other user activity (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5), and that the advertiser can utilize a wide range of criteria for sending advertising (Fig. 3; col 6, lines 13-28), and that the frequency of advertisements can be set (col 6, lines 13-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can make user visits to a certain area a criteria for sending advertisements. One would have been motivated to do this in order to target users who are often in a certain area.

Hence, Haitsuka does apply to a mobile user. And, the combination of the prior art renders obvious the features of the Applicant's claims.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

Art Unit: 3622

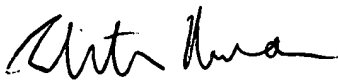
Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
1/25/2007